

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 22, 2007. In the Office Action, Claims 112-157 are pending and stand rejected by the Examiner. Applicants have added new dependent Claim 158. In order to advance prosecution of this Application, Applicants have responded to each notation by the Examiner. Applicants submit that all of the pending claims are allowable over the cited references. Applicants respectfully request reconsideration and favorable action in this case.

Claim Rejection 35 U.S.C. § 103

The Examiner rejects Claims 112-113, 115-117, 119-125, 127-128, 131-133, 135-142, 144-152, 154-155, and 157 under 35 U.S.C. § 103(a) as being unpatentable over *Knott* in view of “WEXTOR: A Web-based tool for generating and visualizing experimental designs and procedures,” by Reips et al. (“*Reips*”). The Examiner also rejects Claims 114, 118, 120, 126, 129, 131, 134, 138, 142, 144, 150, 153, and 157 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of *Knott* and *Reips* with “Designing and Developing Surveys on WWW Sites,” by Feinberg et al. (“*Feinberg*”) and U.S. Patent No. 6,654,447 issued to Dewan (“*Dewan*”). For the reasons discussed below, Applicants request reconsideration and allowance of all pending claims.

A. The Proposed Combinations are Improper

First and foremost, Applicants respectfully submit that one of ordinary skill in the art at the time of Applicants’ invention would not have been motivated to combine the teachings of *Knott* with those of *Reips*. It is clear based at least on the many distinctions discussed below that the proposed *Knott-Reips* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicants respectfully submit that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicants’ claims as a blueprint, in an attempt to reconstruct Applicants’ claims.

1. The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various

prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* ***Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an Applicants' disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "***The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.***" M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome ***wherein that which only the invention taught is used against its teacher.***'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, ***explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:***

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is ***rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.*** Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. The Analysis

According to the Examiner with regard to independent Claim 112, “[i]t would have been obvious to one skilled in the art at the time of applicants invention to modify the teachings of *Knott* with the teachings of *Reips* . . . with the motivation of utilizing a dynamic structure which picks up the user’s choices and written text and subsequently structures itself accordingly.” (Office Action, page 4). The Examiner makes similar statements with regard to independent Claims 127, 132, and 151. However, because *Knott* and *Reips* are entirely different systems based on different principles of operation and, thus, non-analogous, Applicants submit that the proposed modification to *Knott* can only result by piecing together the elements of Applicants’ claims in a piece-meal fashion with the benefit of hindsight.

Specifically, *Knott* relates to an adaptive voice recognition system and more specifically, to “touch-tone menus based on the frequency of caller requests for information and for adapting a voice recognition and touch-tone content for information retrieval systems.” (*Knott*, page 1, paragraph 2). Thus, the system provides a solution directed to telephone call centers since “the nature of caller inquiries to a calling center may vary substantially.” (*Knott*, page 1, paragraph 4). By contrast, *Reips* relates to a web-based tool that “dynamically creates the customized Web pages and Javascripts needed for [generating and visualizing experimental designs and procedures].” (*Reips*, page 234, Title and Abstract). Thus, the system “picks up the user’s choices and written text and subsequently structures itself accordingly.” (*Reips*, page 235, paragraph 7). Accordingly, the text-based system of *Reips* is entirely different from the telephone-based system of *Knott*. It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). Because the advantages, properties, utilities, and results of the *Knott* are non-analogous to the advantages, properties, utilities, and results of the *Reips* system, Applicants submit that a person skilled in the art at the time of the invention would not have had the required motivation to combine the telephone-based system of *Knott* with the web and text-based system of *Reips*, as proposed by the Office Action. In this respect, Applicants respectfully submit that the references are non-analogous art and, because not related, an improper combination.

Furthermore, it is improper for an Examiner to use hindsight having read the Applicants' disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The inconsistencies in *Knott* and *Reips*, as identified by Applicants above, evidences the Examiners reconstruction of Applicants' claims by using hindsight to piece together disjointed portions of non-analogous and inconsistent references. It does not follow that one of ordinary skill in the art would have been motivated to utilize the "dynamic structure [of *Reips*] which picks up the user's choices and **written text** and subsequently structures itself accordingly," as proposed by the Examiner (Office Action, page 4) since *Knott* deals with voice recognition and not written text.

For at least these reasons, Applicants submit that the proposed *Knott-Reips* combination is improper. For similar reasons, Applicants submit that the proposed *Knott-Reips-Feinberg* and *Knott-Reips-Dewan* combinations are also improper. Applicants respectfully requests reconsideration and allowance of Claims 112-158.

B. Claims 112-126 are Allowable

The Examiner relies upon the proposed *Knott-Reips* combination to reject independent Claims 112. Applicants respectfully submit, however, that the proposed combination of references does not disclose, teach, or suggest the elements recited in Applicants' Claim 112.

For example, independent Claim 112 of the present Application, as previously amended, recites:

A method for providing data collection from a client at a data collection mechanism, the method comprising:
collecting from a client during a communication session a first portion of data using an automated data collection mechanism and using at least a portion of a first script comprising one or more queries for information to the client;

associating the client with a live agent during the communication session based at least in part on an event associated with the client's interaction with the automated data collection mechanism;

populating at least a portion of a second script with at least some of the first portion of data collected from the client during the communication session; and

after associating the client with the live agent and during the communication session, collecting a second portion of data from the client using the second script, wherein the second script comprises at least one query for information not yet presented to the client by the first script.

Thus, the claim recites “associating the client with a live agent during the communication session . . . ” **and then** “after associating the client with the live agent and during the communication session, collecting a second portion of data from the client using the second script, wherein the second script comprises at least one query for information not yet presented to the client by the first script.” In the Office Action, the Examiner rejects Claim 112 over the proposed *Knott-Reips* combination but relies specifically upon *Knott* for disclosure of both of the above recited steps. Applicants respectfully submit, however, that *Knott*, as relied upon by the Examiner, does not disclose, teach, or suggest the recited combination of features.

Rather, *Knott* discloses “a system for analyzing call request topics and setting a call menu for improved automated response in accomplishing caller tasks.” (Page 2, paragraph 17). To the extent that system disclosed in *Knott* utilizes an operator, such use is limited to the situation in which “a caller is unable to receive information from the automated response of IVR 10.” (Page 2, paragraph 17). Only “[i]f a caller is unable to receive information from the automated responses of IVR 10, then the caller is forwarded to an operator 16 interfaced with IVR 10 for individual handling.” (Page 2, paragraph 17). There is no disclosure by *Knott*, however, of the procedure used after the caller is forwarded to the operator. As shown in the flow diagram of Figure 2 of *Knott*, the method appears to terminate after the caller is allowed “to select interaction with an operator.” (Figure 2; Page 3, paragraph 34). This fact is supported by the purpose of *Knott*, which is described as providing a menu that “expedites the identification of caller tasks and helps ensure accurate and timely transfer of requested information, **thus reducing the likelihood that a caller will request or need operator intervention.**” (Page 2, paragraph 19, emphasis added). Thus, operator intervention is

outside of the scope of the process described in *Knott*. Because *Knott* does not disclose any details related to the intervention of a call by an operator, Applicants submit that *Knott* cannot be said to disclose, teach, or suggest “**after associating the client with the live agent and during the communication session, collecting a second portion of data from the client using the second script**, wherein the second script comprises at least one query for information not yet presented to the client by the first script,” as recited in Applicants’ independent Claim 112.

Furthermore, the section of *Knott* relied upon by the Examiner does not disclose, teach, or suggest the recited claim elements. The Office Action specifically relies paragraph 37 of *Knott* for disclosure of Applicants’ step of “**after associating the client with the live agent . . . , collecting a second portion of data from the client using the second script . . .**” The relied upon portion of *Knott* merely discloses, however:

. . . At step 60, a script presents the caller with the types of information available for the selected service and instructs the caller to select desired information by either a voice utterance or DTMF selection . . . The script for each service varies dependent upon the type of information available for the service, and includes DTMF inputs as well as voice recognition inputs for the caller to select desired information.

(Page 4, paragraph 37). There is no disclosure that the script referred to by the cited portion of *Knott* is presented “after associating the client with the live agent,” as recited in independent Claim 112. To the contrary, and for the reasons discussed above, *Knott* indicates that the script referred to is presented to the caller prior to a caller requesting operator intervention. Because the system of *Knott* presents operator intervention as a last resort, Applicants respectfully submit that *Knott* (and thus the proposed *Knott-Reips* combination) does not disclose, teach, or suggest “after associating the client with the live agent and during the communication session, collecting a second portion of data from the client using the second script, wherein the second script comprises at least one query for information not yet presented to the client by the first script,” as recited in Applicants’ independent Claim 112.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim 112, together with Claims 113-126 that depend on Claim 112.

C. Claims 127-157 are Allowable

The Examiner also relies upon the proposed *Knott-Reips* combination to reject independent Claims 127, 132, and 151. Applicants respectfully submit, however, that the proposed *Knott-Reips* combination does not disclose, teach, or suggest each and every element of Applicants' independent Claims 127, 132, and 151.

For example, Claim 127 recites "a live agent operable to collect from the client during the communication session a second portion of data using a second script . . . wherein the second script comprises at least one of the one or more queries for information presented to the client by the first script, and wherein the second script comprises at least one query for information not yet presented to the client by the first script." As another example, Claim 132 recites "after associating the client with the second data collection mechanism and during the communication session, collecting from the client a second portion of data using the second script." Thus, for reasons analogous to those discussed above with regard to Claim 112, Applicants respectfully submit that the proposed *Knott-Reips* combination does not disclose, teach, or suggest the elements set forth in Applicants' independent Claims 127, 132, and 151.

Additionally, Applicants respectfully submit that the proposed *Knott-Reips* combination, as applied to Claims 127, 132, and 151, is deficient for reasons independent of those discussed above. For example, independent Claim 127 recites "wherein the second script comprises at least one of the one or more queries for information presented to the client by the first script" **and** "wherein the second script comprises at least one query for information not yet present to the client by the first script." Independent Claims 132 and 151 recite certain analogous features.

In the Office Action, the Examiner relies upon paragraph 23 for disclosure of the first script and relies upon paragraph 37 of *Knott* for disclosure of the second script. Paragraph 23 discloses the following:

After the greeting, the process proceeds to step 28 where the caller is instructed to "Please identify your task," followed by a pause to allow an opening statement utterance. IVR 10 then lists the menu options and an associated DTMF tone in a predetermined order, such as in the order of frequency of the requests by callers. For instance, an example script read by IVR 10 at step 28 is:

"Please identify you task."

"One. How to use a service."

"Two. Sales information about a service."

"Three. What services do I currently have."

"Four. How much does a service cost."

"Five. Get information about one of my services."

"Six. Who is my long distance carrier."

(Page 3, paragraphs 23-30). Following the user's selection of a task, "IVR 10 accepts the caller input, determines the menu node selected by the caller input and advances the input to task analyzer 20 for classification of the task requested by the client." (Page 3, paragraph 32). Thus, the script disclosed in paragraphs 23-30 is used to illicit "an opening statement regarding the purpose of the call" for determining the appropriate menu node to send the user to. (Page 3, paragraph 22).

With respect to the script relied upon by the Examiner as being analogous to Applicants' "second script", the cited portion of *Knott* merely discloses:

. . . At step 60, a script presents the caller with the types of information available for the selected service and instructs the caller to select desired information by either a voice utterance or DTMF selection. For instance, the caller is presented four types of information for the identified service. One type of information is a description of service functionality such as the definition of the service and its objectives. Another type of information is set up information, such as instructions for turning the service on and off. Another type of information is usage information, such as instructions on how to use the service. Another type of information is how to change service functions. The script for each service varies dependent upon the type of

information available for the service, and includes DTMF inputs as well as voice recognition inputs for the caller to select desired information.

(Page 4, paragraph 37). Thus, the script of step 60 of *Knott* merely presents to the caller the requested information. There is no disclosure that the script of step 60 “comprises at least one of the one or more queries for information presented to the client by the first script,” as recited in independent Claims 127, 132, and 151.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 127, 132, and 151, together with Claims 128-131, 133-150, and 152-157 that depend on these Claims 127, 132, and 151, respectively.

No Waiver

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the *Knott*, *Reips*, *Feinberg*, and *Dewan* references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

New Claim 158 is Allowable

New Claim 158 has been added and is fully supported by the original specification. No new matter has been added. New Claim 158 depends upon independent Claim 112. Claim 158 is not obvious over the proposed *Knott-Reips* combination because Claim 158 includes the limitations of independent Claim 112.

Additionally, Claim 158 recites “providing, to the live agent, the second script,” which further distinguish the art. This operational step is not disclosed, taught, or suggested by *Knott* or *Reips*, whether considered alone or in combination. As discussed above, *Knott* merely discloses that “[i]f a caller is unable to receive information from the automated responses of IVR 10, then the caller is forwarded to an operator 16 interfaced with IVR 10 for

individual handling.” (Page 2, paragraph 17). There is no disclosure by *Knott* of the procedure used after the caller is forwarded to the operator. As shown in the flow diagram of Figure 2, the method of *Knott* terminates after the caller is allowed “to select interaction with an operator.” (Figure 2; Page 3, paragraph 34). Because the very purpose of the system of *Knott* is to “[**reduce**] **the likelihood that a caller will request or need operator intervention**” (Page 2, paragraph 19, emphasis added) and because *Knott* does not disclose any details related to the intervention of a call by an operator, Applicants submit that *Knott* does not disclose, teach, or suggest “providing, to the live agent, the second script,” as recited in Applicants’ new Claim 158.

For at least these reasons, Applicants respectfully requests consideration and allowance of new independent Claim 158.


CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. Because this Amendment places all claims in condition for allowance or at least in a better condition for appeal, Applicants respectfully request that this Amendment be entered.

Applicants believe that no fees are due. However, the Commissioner is authorized to charge any fee or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

If the Examiner feels that a conference would advance prosecution of this Application in any manner, Jenni R. Moen stands willing to conduct such a telephone interview at the convenience of the Examiner. Mrs. Moen may be reached at 214-953-6809.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants


Jenni R. Moen
Reg. No. 52,038

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Correspondence Address:

 X Customer Number

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